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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,941	12/10/2003	Allon G. Englman	WMS-037	6669

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JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER	
OMOTOSHO, EMMANUEL	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/731,941	ENGLMAN ET AL.	
	Examiner	Art Unit	
	Emmanuel Omotosho	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US 2003/0216169 A1. Walker et al. discloses a gaming machine capable of providing a benefit mode (enhanced mode) during a game session (Page 1 Section 0014). The benefit mode provides extra game features that are considered beneficial to the player. It should be noted that the 'benefit mode' is being viewed as the 'enhanced mode'. After a player begins the game (initial mode), the controller will determine if certain conditions are present. If the conditions are met, the controller will display a video message indicating that a benefit mode with certain benefits will be provided if the credit balance is increased (Page 1 Section 0014). If the player inserts more credits (Page 5 Section 0044), a set of benefits will be provided to the player and the player can then select a particular benefit by inputting his/her selection through an input device (Page 5 Section 0054). It should be noted that the step of 'player inserting more credits' is being viewed as 'the second wager'.

3. In regards to claim 3-6, Walker et al. discloses the benefit as an increase in the probability of entering a bonus round (Page 6 section 0059). It should be noted that it is well known in the art of wagering game for the game machine to award a bonus round

as means to further entertain the player. Moreover, Walker et al. also disclose a few benefits that increase the value payout average of a game. One way is through extra coins for any outcome once the benefit mode is activated. With this benefit, a player can use the coin for more spins which will result in an increase in value payout average when compare to the base mode (Page 5 Section 0058).

4. In regards to claim 7-8, Walker et al. discloses the benefit as awarding an extra credits to the player in a wining outcome, this increases the value associated with the wining outcome. Furthermore, the benefit could also award a credit amount when there is no wining outcome (Page 5 Section 0058).

5. As mentioned above, Walker et al. discloses a method for entering a benefit mode when a 'certain condition' is met after the player starts the game play. As mentioned above, Walker et al. also discloses one of the benefit modes to be an increase in the value payout of an outcome. Therefore in regards to claims 10-13, it is an obvious choice for the casino operator to choose the 'certain condition' to be the condition where n out of x reels are displayed. Where n is greater than x and x is the number of reels in the array of reels for the casino game. This further entertains and entices the player to bet more money now knowing the value for n number of reels.

6. Claims 14-23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. as applied above, and further in view of Marks et al. US 6960133B1. Walker et al. discloses all subject matters except the capability of repositioning a wild symbol to maximize the value payout to the player. Moreover, Walker et al. disclose that the benefits provided to the player are not limited to the ones mentioned in the

examples (Page 5 section 0057) and that modifications to the system could be made by those skilled in the art (Page 8 section 0084). However Marks et al. discloses a method for repositioning predetermined symbol to maximize the players value payout when a predetermined symbol appears in the displayed reel symbol array (Column 6 lines 41-52). Marks et al. further pointed out that the predetermined symbol eligible for repositioning could be a wild symbol (Column 14 lines 30-37). Therefore, it would be obvious to someone of ordinary skill at the time of the invention to combine Walker et al.'s reference with Marks et al.'s reference in an effort to increase the players interest and excitement by offering more benefits to the player if the player places more wager. However, even though Mark et al. did not specifically show a change in color of reel symbols, it is well known in the art to change the color of a particular symbol as means to further entertain the user and indicate a jackpot activity or a specific bonus round activity.

7. Claims 24 - 49, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. and Marks et al. as applied above, and further in view of Meyer. US App No. 09/971139. Walker et al. discloses a gaming machine or a network of gaming machines (Page 11 Section 0189) capable of providing a benefit mode (enhanced mode) upon a triggering event (e.g. more credits added) during a game session (Page 1 Section 0014). The benefit mode provides extra game features that are considered beneficial to the player. Walker et al. discloses all subject matters except specifically choosing the extra game feature to be an extra symbol added to the reel or an extra pay line added to the game. However, in a similar invention offering a bonus game during a

base game, Meyer disclose the bonus round comprising a game feature capable of adding extra symbol/pay lines on the display screen to further escalate the game activity as the game progresses and further maintain the players interest (Page 2 Section 0035-0037). Moreover, Walker et al. disclose that the benefits provided to the player are not limited to the ones mentioned in the examples (Page 5 section 0057) and that modifications to the system could be made by those skilled in the art to further maintain the players interest and attract more players to such gaming device (Page 8 section 0084). Therefore it would be obvious for someone of ordinary skilled in the art at the time of the invention to have combined the references art to further maintain the players interest and attract more players to such gaming device.

Response to Arguments

8. Applicant's arguments filed 2/05/2007 have been fully considered but they are not persuasive.

9. On page 14, applicant argues, "Claims 1-13 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Application No. 60/373,749 to Walker et al. ("Walker provisional"). Walker is a provisional application to which U.S. Patent Application Publication No. 2003/0216169 ("Walker publication") claims priority. It is apparent that the Examiner is referring to the Walker publication in rejecting claims 1-13 because the Examiner's citations, such as "Page 1 Section 0014," seem to be present only in the Walker publication (e.g., there is no section 0014 on page 1 of the Walker provisional). Accordingly, this response will refer to the Walker publication ("Walker")."

10. However, applicant should note that parent and child applications are all linked. For example, using Walker publication as reference inherently incorporates the disclosure of the parent application because of the parent/child application relationship (See Walker publication Page 1 paragraph 0001).

11. On page 15, applicant argues, "A wager is necessarily distinct and, in fact, inversely related to a credit balance. A second wager necessarily decreases the credit balance resulting in a lower credit balance. Accordingly, Walker teaches away from using a second wager to activate what the Examiner deems the "enhanced mode." Clearly, motivating a player to achieve and/or maintain "higher balances" is directly contrary to detecting a second wager for enabling enhanced game play."

12. The examiner respectfully disagrees. Applicant should be reminded that all claims are given their broadest reasonable interpretation. The phrase "second wager" is broad and thus is being given its broadest and reasonable interpretation. The phrase "second wager" can be interpreted to be a wager that is different from the first wager. As described above, Walker teaches placing a first wager and also a second wager. It should be further noted that even though applicant's claims are read in light of the specification, applicant has not provided a definition of "second wager" in the claim language, so it is open to its broadest reasonable interpretation. Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. On page 16, applicant argues, "A skilled artisan would not know how to display the full outcome of the wagering game by looking at Walker's increase in the payout

value. To support the obviousness allegation, there must be at least a direct relationship between the increasing a payout value and displaying a full outcome. No such relationship exists. For example, the payout value can be changed (e.g., increased) regardless of whether a full outcome of the wagering game is displayed. Thus, the Applicants respectfully submit that claim 10, along with all claims dependent therefrom, is patentable over Walker at least for the above-stated applicable reasons."

14. However, the applicant hasn't show why a skilled artisan would not know how to display the full outcome of the wagering game by looking at Walker's increase in the payout value. Thus the examiner still believes a skilled artisan would know how to display the full outcome of the wagering game. Simply because, in conjunction with the above stated reasoning, Walker already disclose a display device, a processor capable of determining the outcome of the game and a controller programmed to display the information on said display device (Page 2 Par 0024).

15. On page 16, applicant argues, "For example, there is no allegation that any of the cited references teach or suggest "an adaptable mechanical spinning reel slot machine including a plurality of electro-mechanical reels" or a "flat panel transmissive display positioned in front of the electro-mechanical reels," as claimed by claim 23. Thus, the Applicants respectfully submit that claim 23 is patentable over Walker in view of Marks at least for the above-stated applicable reasons."

16. The examiner respectfully disagrees and still maintains the 35 U.S.C. § 103 rejection as being unpatentable over Walker in view of Marks. The examiner should further point out that both Walker and Marks disclose the adaptable

mechanical/electromechanical spinning reel slot machine (Marks Fig 1, Col 1 lines 15-25) and the flat panel transmissive display (Walker Page 2 Par 0021).

17. On page 17, applicant argues, "Regarding claim 24, the office action alleges that Meyer discloses "adding extra symbol/pay lines on the display screen." Claim 24 is directed to "displaying a first extra reel symbol above a first reel symbol array" (see, e.g., symbol 720 displayed in FIG. 13 of the current invention) and to "an option to activate a possibility of an additional movement of the first reel." Nowhere does Meyer teach or suggest these claim elements. For example, Meyer discloses, at most, that an array 20 may be extended by the "addition of more rows and/or columns." Meyer does not teach or suggest, however, having a symbol above a reel symbol array or additional movement of a reel"

18. The examiner respectfully disagrees. As stated above, Meyer discloses the addition of extra symbols/pay lines on the display screen (Fig 2, Page 2 Par 0035). The examiner fail to see the difference between adding a row of symbols/pay lines and adding a symbol/pay line to the reels. A row of symbols contains symbols. If a row of symbols is added to the reels, the reels are extended by the symbols. Meyer discloses the extension feature as described above and the examiner still has not seen the evidence that this feature is different from what the applicant is trying to claim.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Omotosho whose telephone number is (571) 272-3106. The examiner can normally be reached on m-f 8-430.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

Ronald Laneau
PRIMARY EXAMINER
3/19/07